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| 09/182,102      | 10/27/98    | HAAF                 | T A-65680-2/RF      |

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HM12/0831

EXAMINER

BRUSCA, J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1636

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DATE MAILED:

08/31/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/182,102

Applicant(s)  
Haaf et al.

Examiner  
John S. Brusca

Group Art Unit  
1636



☒ Responsive to communication(s) filed on 7/22/99

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 18, 19, and 21 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 18, 19, and 21 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Specification*

1. The objection to the specification in the Office Action mailed 1/19/99 is withdrawn in view of the Amendment received 7/22/99.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The rejection of claim 21 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention in the Office Action mailed 1/19/99 is maintained for reasons of record.
4. Applicant's arguments filed 7/22/99 have been fully considered but they are not persuasive. The Applicants state that the instant specification describes variant Rad 51 genes as Rad 51 genes that encode a protein with an aberrant function. However neither the specification nor the prior art shows any disease that correlates with an aberrant Rad 51 gene,

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as required by the claimed invention. As such, undue experimentation would be required to practice the diagnostic method of claim 20.

5. The rejection of claims 18-21 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the Amendment received 7/22/99.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 is indefinite because it depends from a cancelled claim. The rejection would be overcome by amending claim 21 to depend from claim 19.

For the purpose of examination, the claims have been assumed to incorporate the suggested amendments.

### *Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The rejection of claims 18 and 19 under 35 U.S.C. 102(b) as being anticipated by Ogawa et al. in the Office Action mailed 1/19/99 is maintained for reasons of record.
10. Applicant's arguments filed 7/22/99 have been fully considered but they are not persuasive. The Applicants state that Ogawa et al. is not prior art under 35 U.S.C. § 102(b), however Ogawa et al. was published in 1993. The Applicants refer to a library receipt date of 3/5/98, but the referred to date applies to the Vispe et al. reference cited under 35 U.S. C. § 112, first paragraph in the Office Action mailed 1/19/99. The Applicants state that Ogawa et al. does not anticipate the claimed invention because it compares Rad 51 sequences from different species of organisms, however the claimed invention reads on comparison of Rad 51 sequences from different species of organisms.

#### *Conclusion*

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until

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after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. For routine submissions the FAX number is (703) 308-4242. For FAX transmissions in cases in which the Examiner has been notified by phone to expect the transmission, the FAX number is (703) 305-7939. In such cases please call the Examiner at (703) 308-4231 at the time of transmission to expedite delivery of the fax. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6 (d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca, Ph.D. whose telephone number is (703) 308-4231. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, Ph.D., can be reached at (703) 308-4003.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, appearing to read "John S. Brusca".

John S. Brusca, Ph.D.

Primary Examiner